REMARKS

No amendments have been made and no new matter has been introduced.

Claims 1-33 are currently pending and under consideration. Claims 9-33 have been allowed. Applicants gratefully acknowledge the same.

Reconsideration of claims 1-8 is respectfully requested.

Claim Rejections Under 35 U.S.C. § 102(b) and 35 U.S.C. 103(a)

Claims 1, 2, 5 and 7 stand rejected under 35 U.S.C. § 102(b), as being allegedly anticipated by "Japan," by which the Applicants infer the Examiner intends Japanese Patent No. JP411002592A to Ataka et al. (hereinafter "Japan"). (Office Action dated March 30, 2009, page 2 and form PTO-892) The Examiner states on page 2 of the Detailed Action that, "Japan appears to show a mercury recovery process from broken fluorescent bulbs."

To anticipate a claim, a reference must disclose each and every limitation of the claim. *Lewmar Marine v. Varient Inc.*, 3 U.S.P.Q.2d 1766 (Fed. Cir. 1987).

In addition, claims 1-8 stand rejected under 35 U.S.C. § 103(a), as being allegedly unpatentable over Japan. The Examiner states on page 2 of the Detailed Action dated March 30, 2009 that Japan shows a fluorescent lamp mercury recovery process and that the remaining claim limitations would have been obvious.

For an obviousness rejection to be proper, the Examiner is expected to meet the burden of establishing why the differences between the prior art and that claimed would have been obvious. (MPEP 2141(III)) "A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *KSR Int'l Co. v. Teleflex Inc.,* 127 S.Ct. 1727, 1741 (2007). To find obviousness, the Examiner must "identify a reason that would have prompted a person of ordinary skill in the art in the relevant field to combine the elements in the way the claimed new invention does." *Id.*

Applicants respectfully traverse these rejections for at least the following reasons and respond to them together.

First, the Applicants respectfully note that the Examiner has not indicated which elements of Japan correspond to the elements of the instant claims. The MPEP provides that in making a rejection under 35 U.S.C. § 103, for example, the Examiner should set forth "the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s)." (MPEP 706.02(j)) Because the Examiner has not indicated where Japan discloses or suggests any element of claims 1-8, the Applicants respectfully assert that the Examiner has not made a proper rejection under 35 U.S.C. § 102 or 35 U.S.C. § 103.

Second, the Examiner alleges that, "Japan shows a fluorescent lamp mercury recovery process." (Office Action dated March 30, 2009, p. 2) Japan is related to a method for fractionally measuring an amount of effective mercury generating light and an amount of non-effective mercury not generating light in order to reduce a total amount of mercury within a discharge lamp wherein broken pieces of a fluorescent lamp are heated at a temperature of 40°C. (Japan paragraph [0010]) Thus not only does Japan not disclose or suggest a method of recycling a fluorescent lamp a recited in claim 1, Japan is non-analogous art. Therefore one of ordinary skill in the art would not have been prompted by Japan to consider the claimed method, as the Examiner seems to allege.

Third, the method of recycling a fluorescent lamp as recited in claim 1 of the present invention includes, *inter alia*, "heating broken pieces of fluorescent lamps at a temperature of about 100°C to 330°C to form a gas containing a mercury vapor." Japan does not disclose or suggest heating broken pieces of fluorescent lamps at a temperature of about 100°C to 330°C to form a gas containing a mercury vapor. Japan discloses a method of measuring an amount of effective mercury. (Japan, paragraph [0010])

Fourth, the method of recycling a fluorescent lamp as recited in claim 1 of the present invention includes, "cooling the gas containing the mercury vapor at a temperature of about -38°C to about 0°C to form a liquid mercury" and "collecting the liquid mercury." The method for fractionally measuring the amount of effective mercury and the amount of non-effective mercury as disclosed by Japan does not require a step of cooling a gas containing mercury vapor. Also, Japan discloses "liquid N_2 trap 9" (Japan, Abstract), which one of ordinary skill in the art would understand to refer to liquid nitrogen, which has a temperature of –198°C. Thus Japan does not disclose or suggest the above-mentioned claim elements, including cooling the gas

containing the mercury vapor at a temperature of about **-38°C to about 0°C** to form a liquid mercury.

Fifth, the Examiner alleges that the "particular temperatures used to perform this function would have been well within the scope of one skilled in the art in order to recover the liquid mercury once the basic Japan process was known." (Office Action dated March 30, 2009, p. 2) Because Japan is related to a method for fractionally measuring the amount of effective mercury generating light and the amount of non-effective mercury not generating light in order to reduce the total amount of the mercury within a discharge lamp, Japan is distinct from and non-analogous to the claimed method of recycling a fluorescent lamp. Thus one of ordinary skill in the art would not have been prompted to consider the claimed temperatures, as suggested by the Examiner, for this reason as well.

Therefore the Applicants respectfully submit that claims 1-8 patentably distinguish over the cited references for at least the reasons mentioned above. Accordingly, withdrawal of the rejection of claims 1, 2, 5 and 7 under 35 U.S.C. § 102(b) and the rejection of claims 1-8 under 35 U.S.C. § 103(a), and allowance of the instant claims, are respectfully requested.

Conclusion:

All of the outstanding rejections are herein overcome. Reconsideration and withdrawal of all rejections and prompt issuance of a Notice of Allowance is respectfully requested. No new matter is added by way of the foregoing Remarks.

The Examiner is invited to contact Applicant's attorney at the below-listed phone number regarding this Response or otherwise concerning the present application.

If there are any charges due with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130 maintained by Applicant's attorneys.

Respectfully submitted,

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